

Docket No.: 99 P 7399 US
App. No.: 09/457,049

REMARKS

Status of Claims

After entry of the Previous Amendment and then the above amendments, claims 1-7, 9-33 and 35 would be pending. Claims 1, 6, 15, 16, and 21 were amended, and claim 34 was canceled, by the above amendments. For ease of discussion, claims rejections may be discussed below as if applied even to claims just amended above.

The Advisory Action maintained the rejections from the Final Office Action, and positively stated a rejection of claim 1 under 35 U.S.C. §112, second paragraph (hereinafter, "Section 112, second paragraph").

Per the Final Office Action:

Claims 1-3, 16, 21-23, 26 and 27 stand rejected under 35 U.S.C. §103(a), (hereinafter, "Section 103(a)") as being unpatentable over Wood et al. (U.S. Patent 6,091,808) (hereinafter "Wood").

Claims 4, 17-20, 28, and 33 stand rejected under Section 103(a) as being unpatentable over Wood in view of Brennan et al. (U.S. Pat. 5,329,578), (hereinafter, "Brennan").

Claim 24 stands rejected under Section 103(a) as being unpatentable over Wood in view of Cheston, III et al. (U.S. Patent 6,330,308) (hereinafter, "Cheston").

Claim 25 stand rejected under Section 103(a) as being unpatentable over Wood in view of Herbst (U.S. Patent 4,941,170).

Claim 5 stand rejected under Section 103(a) as being unpatentable over Wood in view of Brennan and further in view of Kugell et al. (U.S. Patent 5,802,160) (hereinafter, "Kugell").

Claims 6, 9-15, 29-32, 34, and 35 stand rejected under Section 103(a) as being unpatentable over Kugell in view of Brennan.

Claim 7 stands rejected under Section 103(a) as being unpatentable over Kugell in view of Brennan and further in view of Will (U.S. Patent 5,905,789).

The Advisory Action included specific discussion of claim elements that correspond to claims 1, 21, 22, 16, 6, 34 and 26 (in order of discussion). Accordingly, the following discussion will proceed in the same order.

Docket No.: 99 P 7399 US

App. No.: 09/457,049

Claim 1 and Section 112, second paragraph [Advisory Action, Paras. 1-2]

Applicants have amended Claim 1 to recite:

... automatically sending, by said computer system, a message via a first contact method toward, at least, a person other than said called party ...

Accordingly, claim 1 now provides additional words regarding "who/what is sending/receiving a message", as requested in the Advisory Action. Accordingly, Applicants respectfully submit that claim 1 is now even more allowable under Section 112, second paragraph.

Claim 1 and Wood [Advisory Action, Paras. 3-4]

Claim 1 stands rejected under Section 103(a) as being unpatentable over Wood.

In the rejections of many claims using Wood, the Examiner has equated the remote telephone dialer machine from Wood (Web Facility 22, FIG. 1, Wood) as supplying the "response" of Applicants' claims. [See, Final Office Action, Item 3, and Wood, FIG. 1, to see that the alleged "message" goes into Wood's Web Facility 22 and the alleged "response" comes out of the Web Facility 22 to thereby mean, given the context of Wood, that the response is supplied by the Web Facility 22.]

Claim 1, as amended, now recites "automatically sending ... a message via a first contact method toward, at least, a person other than said called party" and ... receiving a response to said message from said person, ..."

Applicants respectfully submit that the mere remote dialer machine (Web Facility 22) from Wood even more than ever cannot be construed as corresponding to, now, the "person" recited in claim 1 from whom a "response" is received.

Furthermore, there is no suggestion anywhere somehow to modify Wood to obtain the features of claim 1. On the contrary, Wood's remote dialer machine does not even recognize the problem addressed by claim 1 of "locat[ing] a called party". Instead, Wood's remote dialer machine merely replicates the function of a standard telephone, albeit on an Internet server instead of at a user's fingertips. In fact, Wood's remote dialer machine assumes and requires that the phone number is already known by the

Docket No.: 99 P 7399 US
App. No.: 09/457,049

caller. Thus, Wood actually teaches away from the problem and the solution of Applicants' claim 1.

Accordingly, Applicants respectfully submit that, more than ever, claim 1 is allowable over Wood.

Claim 21 [Advisory Action, Paras. 5-6]

Claim 21 stands rejected under Section 103(a) as being unpatentable over Wood.

Claim 21 depends on claim 1 and includes all limitations of claim 1. Accordingly, Applicants respectfully submit that claim 21 is allowable for at least the same reasons, discussed above and previously, as is claim 1.

Applicants further respectfully submit that claim 21 is further allowable for the features that it recites.

The Advisory Action alleged that "the second contact method includes a telephone number that is entered in full by a responding party" of claim 21 is taught by Wood because:

Wood teaches (col. 6, line 42 through col. 7, line 9) that the caller would have the option to click a dial button that triggers the telephone switch to set up a telephone connection between the subscriber's telephone 10 and the called party or pick up the phone 10 and dial the full telephone number.

Applicants respectfully disagree. Applicants are surprised and puzzled by the above-quoted analysis from the Advisory Action. In the above-quoted passage, the Advisory Action states merely that, in Wood, the caller can himself manually dial a telephone to call a called party, instead of using the one-click automatic dialer of Wood. Thus, the Advisory Action is equating Wood's caller with the "responding party" of claim 21.

Applicant's respectfully submit that it is inconsistent and unfair to equate, for claim 21, Wood's caller with the "responding party" of claim 21, in view of the fact that, in rejecting the base claim 1, the "responding party" was essentially equated with the remote telephone dialer of Wood. [See, Final Office Action, Item 3, which equates the

Docket No.: 99 P 7399 US
App. No.: 09/457,049

"telephone connection message" of Wood (which goes from Wood's Web Browser 12 to Wood's Web Facility 22, Wood, FIG. 1) to the "message ... via a first contact method" of claim 1.] In short, the Advisory Action's new analysis with respect to the feature of claim 21 is completely incompatible with the Final Office Action's analysis with respect to the remaining features of claim 21 that are supplied by the base claim 1.

If the Advisory Action's analysis for claim 21 is to be kept, then the Final Office Action's analysis for claim 1 would fail for numerous reasons, including the reason nothing from Wood, or from any rational modification of Wood, would correspond to a "message" that the caller would be sending to himself via a first contact method requesting location information regarding the called party. If the Final Office Action's analysis for claim 1 is to be kept, then the Advisory Action's analysis for claim 21 would fail. In any event, the analysis for claim 1 cannot be kept, as has been discussed above. Thus, it is seen that all features of claim 21 cannot be supplied by the references cited to reject claim 21 under any single consistent or reasonable analysis. Accordingly, applicants have shown that claim 21 is further allowable for the features that it recites.

Claim 22 [Advisory Action, Paras. 7-8]

Claim 22 stands rejected under Section 103(a) as being unpatentable over Wood.

Claim 22 depends on claim 1 and includes all limitations of claim 1. Accordingly, Applicants respectfully submit that claim 22 is allowable for at least the same reasons, discussed above and previously, as is claim 1.

The Advisory Action alleged that the "... path 18 to the network constituting the Internet or World Wide Web via URL reads on claimed 'first contact method includes an email [address]'". Applicants respectfully disagree. A URL does not (necessarily) include an email address, and nothing in Wood suggests that the URL used by the human in Wood to communicate with the server in Wood includes an email address. Accordingly, Applicants respectfully submit that claim 22 is further allowable for the features (e.g., "e-mail address") that it recites.

Docket No.: 99 P 7399 US

App. No.: 09/457,049

Claim 16 [Advisory Action, Paras. 10-11]

Claim 16 stands rejected under Section 103(a) as being unpatentable over Wood.

Claim 16, as amended, recites:

a locator (60) capable of sending out location request messages, in response to invocation by a calling party who is seeking to locate said called party, and receiving and handling responses, wherein a response by a person, to a location request message sent to a first destination (22a), indicates a second destination which is to be subsequently called to reach the called party, and said first and second destinations are of different multimedia types

The Advisory Action alleged that the "caller/web browser" of Wood teaches the "first destination" of claim 16, and that the "telephone switch/called party" of Wood teaches the "second destination" of claim 16. Applicants respectfully disagree. If, as alleged, the caller/web browser of Wood is the first destination of claim 16, then that would mean the "location request message" is sent to the caller himself! Further, the amended language in claim 16 makes it even less sensical to send a "location request message" to the caller himself, given that the sending would be "in response to invocation by" the caller himself "who is seeking to locate said called party". There is simply no teaching or suggestion in Wood, or any rational reason anywhere, that any part of Wood's system would send a location request message to the caller himself in the manner required by claim 16. Those of ordinary skill in the art simply would not think to modify Wood so that, for example, a caller can invoke sending requests to himself to answer questions whose answers he does not know. There would be no sense to it.

For the reasons just stated, Applicants respectfully submit that claim 16 is allowable over the cited art.

Claim 6 [Advisory Action, Paras. 12-13]

Claim 6, as amended, recites:

A method for locating a called party comprising:

Docket No.: 99 P 7399 US
App. No.: 09/457,049

receiving a single request to locate a called party;
automatically sending, in response to said single request, messages to multiple parties listed in a contact list requesting location information regarding said called party;
canceling outstanding messages when a response is received to said messages; and
presenting said response to a calling party.

The Advisory Action alleged that Wood teaches the "sending" step from claim 6. The Advisory Action alleges that Wood teaches the "sending" step because FIG. 3 of Woods shows that a caller can dial any one of numerous contacts in the person's contact list. Applicants respectfully disagree. As amended, claim 6 now specifically requires that the automatic sending of the messages to multiple parties is in response to the single request to locate the called party. Wood does not come close to teaching or suggesting such a limitation. On the contrary, Wood can only dial one contact at a time, and even if multiple contacts are dialed in sequence, then nothing teaches that the multiple messages would all be requesting location information regarding said called party.

For the reasons just stated, and for reasons previously stated, Applicants respectfully submit that claim 6 is allowable over the cited art.

Claim 34 [Advisory Action, Paras. 14-15]

Claim 34 has been canceled.

Claim 26 [Advisory Action, Paras. 16]

In connection with Applicants' previous argument that Wood does not teach "recording said second contact method and playing the response for said caller", the Advisory Action asserts that "[s]ince Wood's system would allow subscriber to click a DIAL button to automatically connect to the called party or one may choose to pick up the phone and dial the number. Therefore, there is no need to record the second contact method and playing the response for the caller". Applicant respectfully agrees

Docket No.: 99 P 7399 US
App. No.: 09/457,049

with the Advisory Action's assertion. Applicant believes the assertion actually proves Applicants' point. There is no need to "record ..." in Wood, and therefore Wood does not teach such "recording ..." Further, because there is no need to "record ...", it would not be obvious to modify Wood to "record ...".

For the reasons just stated, and for reasons previously stated, Applicants respectfully submit that claim 26 is allowable over the cited art.

All other pending claims

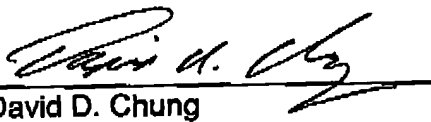
For the reasons just stated, and for reasons previously stated, Applicants respectfully submit that all remaining claims not discussed in the Advisory Action are allowable over the cited art.

CONCLUSION

Therefore, Applicants submit that their invention is not disclosed, taught, or suggested by the references of record. Therefore, it is submitted that all of the claims are allowable over the art of record and it is respectfully requested that the application be passed to allowance.

Respectfully submitted,

Dated: 30 June 03


David D. Chung
Reg. No. 38,409
Phone: (650) 694-5339
Fax 650-968-4517

Correspondence Address:
Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830